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No. 97-360

In The

Supreme Court of the United States

October Term, 1996

UNITED STATES SURGICAL CORPORATION,

Petitioner,

vs.

ETHICON, INC. and JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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COUNTERSTATEMENT OF THE QUESTIONS PRESENTED

1. Was the Federal Circuit correct in holding that "in light of the particular issues in this case concerning the prior art, the claimed invention, and the Court's discussion in *Markman* [*v. Westview Instruments, Inc.*, 116 S.Ct. 1384 (1996)], we conclude that the omission of the requested instructions did not prejudice the determination of obviousness"? *U.S. Surgical Corp. v. Ethicon, Inc*, 103 F.3d, 1554, 1570 (Fed.Cir. 1997).

2. Was the Federal Circuit correct in finding on the facts of this case that there was no reasonable possibility that the submission of a standard dictionary to the jury prejudiced the outcome on obviousness? *Id.*, 103 F.3d at 1569.

PARTIES TO THE PROCEEDING

The petition correctly lists the parties to the proceeding.

Respondents Ethicon, Inc. and Johnson & Johnson Hospital Services, Inc. are wholly owned subsidiaries of Johnson & Johnson. They do not have any wholly-owned subsidiaries.

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PRELIMINARY STATEMENT

Respondents Ethicon, Inc. and Johnson & Johnson Hospital Services, Inc. (collectively, "Ethicon") submit this brief in opposition to U.S. Surgical's petition for a writ of certiorari.

According to U.S. Surgical, the Federal Circuit's decision "effectively negated" this Court's decision in *Markman v. Westview Instruments, Inc.*, 116 S.Ct. 1384 (1996), by "reassign[ing claim construction] to the jury." Petition for Writ of Certiorari ("Pet.") at 10. That argument ignores the facts of this case and mischaracterizes the Federal Circuit's holding.

What the Federal Circuit actually held was that "in light of the particular issues in this case concerning the prior art, the claimed invention, and the Court's discussion in *Markman*, we conclude that the omission of the requested instructions did not prejudice the determination of obviousness." *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1570 (Fed. Cir. 1997). That holding is in harmony with *Markman* and has no applicability beyond the unique facts of this particular case.

STATEMENT OF THE CASE

1. The Facts Pertaining to Obviousness

The patents that U.S. Surgical accused Ethicon of infringing were addressed to a surgical instrument known as an "endoscopic multiple clip applier." After a four-

week trial, the jury unanimously found that U.S. Surgical's claimed invention would have been obvious to a person of ordinary skill in the relevant art.

The starting point in considering obviousness was an extensive body of prior art. U.S. Surgical's technical expert admitted that there was extensive prior art, both on multiple clip appliers and on endoscopic instruments. He also admitted that the *only* difference between the claimed invention and prior art multiple clip appliers was the addition of a long shaft and a seal. *U.S. Surgical v. Ethicon*, 103 F.3d at 1559.

U.S. Surgical's technical expert also admitted that a long shaft and a seal were "characteristics of all endoscopic instruments." *Id.* Numerous prior art endoscopic instruments were in evidence at trial. All of them were long and sealed. *Id.* Moreover, the prior art taught that a long shaft and a seal were essential for *any* endoscopic instrument because of the very nature of endoscopic surgery. Endoscopic surgery is performed by inserting slender instruments through narrow tubes or "cannulas" into an abdominal cavity that has been inflated with carbon dioxide gas. The instruments used in endoscopic surgery need to be long, in order to reach the organs being operated on. And they must be sealed, in order to prevent the escape of carbon dioxide gas. The prior art on endoscopic instruments made that clear.

Because the prior art taught the need for a long shaft and seal in *any* endoscopic instrument, U.S. Surgical

could not credibly deny the obviousness of including those features in making an endoscopic version of a multiple clip applier. And because those two features represented the *only* difference between the claimed invention and prior art multiple clip appliers, it could not seriously deny the obviousness of the claimed invention.

2. Any Disputed Issues on Claim Construction Had No Relevance to Obviousness in this Case

The factors that control a determination of obviousness are well established. Under *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), those factors are: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, such as commercial success or a long-felt but unresolved need.

The admissions of U.S. Surgical's experts eliminated any dispute concerning two of the *Graham* factors, *i.e.*, the scope and content of the prior art and the differences between the prior art and the claimed invention. Those admissions left the parties in agreement that prior art multiple clip appliers had every feature of the claimed invention, except for the two features that admittedly were found in *all* prior art endoscopic instruments, *i.e.*, a long shaft and a seal. *U.S. Surgical v. Ethicon*, 103 F.3d at 1559.

That was true regardless of whether the claims were construed broadly (as U.S. Surgical construed them) or more narrowly (as Ethicon construed them). *See, U.S. Surgical v. Ethicon*, 103 F.3d at 1568. Moreover, any disputes concerning claim construction had no possible bearing on the two remaining *Graham* factors, *i.e.*, the level of ordinary skill and secondary considerations such as commercial success. U.S. Surgical has never argued to the contrary.

3. The Jury's Verdict and the Initial Affirmance by the Federal Circuit

After a four-week trial, the jury found that Ethicon's accused products infringed U.S. Surgical's '420 patent and did not infringe its '057 patent. The jury also found that the claimed inventions under both patents would have been obvious to a person of ordinary skill in the relevant art.

The district court denied post-trial motions by U.S. Surgical for a new trial or for judgment as a matter of law. In ruling on those motions, trial court found that the jury had necessarily adopted U.S. Surgical's construction of the '420 patent without being directed to it. Appendix to Pet. at 46a-50a. U.S. Surgical conceded this. In its appeal brief to the Federal Circuit, U.S. Surgical acknowledged that the jury had "necessarily" adopted its construction of the '420 patent and "necessarily" rejected Ethicon's. U.S. Surgical Appeal Brief at 31. Since the jury adopted U.S. Surgical's construction of the '420 patent without being

directed to it, U.S. Surgical could not have been prejudiced by the trial court's refusal to adopt that construction in its instructions to the jury.

Although the jury implicitly rejected U.S. Surgical's broad construction of '057 patent in finding that it was not infringed, the '057 invention was equally obvious under U.S. Surgical's claim constructions as under Ethicon's. An instruction adopting U.S. Surgical's construction would not have changed the content of the prior art and would not have increased the differences between the prior art and the claimed invention. In short, it would not have made the claimed invention any less obvious.

On appeal to the Federal Circuit, the appeals court summarily affirmed the judgment below.

4. The Federal Circuit's Further Decision Upon Reconsideration in Light of *Markman*

Fourteen months later, this Court rendered its decision in *Markman v. Westview Instruments*, 116 S.Ct. 1384, and remanded this case to the Federal Circuit for reconsideration in light of that decision. *Markman* held that claim construction is an issue of law for the court.

Upon remand for reconsideration in light of *Markman*, the Federal Circuit carefully reviewed the evidence concerning obviousness. It also "reviewed the requested instructions," including the instructions that U.S. Surgical requested on claim construction, for the express

purpose of determining "whether any instructions that were improperly refused could reasonably have prejudiced the jury's verdict of invalidity." *U.S. Surgical v. Ethicon*, 103 F.3d at 1566.

In conducting that review, the Federal Circuit noted that U.S. Surgical failed to "explain how any reasonable claim construction that it requested would have deprived the verdict of obviousness of its support." *Id.*, 103 F.3d at 1570. The Federal Circuit found that "whatever . . . applicability" U.S. Surgical's proposed instructions on claim construction might have had to the issues concerning infringement, "their omission did not prejudice the issue of obviousness." *U.S. Surgical v. Ethicon*, 103 F.3d at 1570. In other words, the Federal Circuit found that the outcome on obviousness would have been same under either U.S. Surgical's broad construction or Ethicon's narrower construction.

After reviewing the evidence and proposed instructions, the Federal Circuit reached a conclusion that was narrowly tailored to the unique facts of this case. It concluded that "in this case none of the rejected instructions [on claim construction] was directed to, or has reasonably been shown to affect, the determination of obviousness." *Id.*, 103 F.3d at 1568. It held that in this case there was no showing of "prejudicial error in the jury instructions." *Id.* The Federal Circuit summarized its holding as follows:

> "On careful consideration of the substance of the instructions on claim construction that the district court declined to give, and the instructions on the issue of obviousness, all in light of the particular issues in this case concerning the prior art, the claimed invention, and the Court's discussion in *Markman*, we conclude that the omission of the requested instructions did not prejudice the determination of obviousness. The criteria for grant of a new trial have not been met." (*Id.*, 103 F.3d at 1570)

After the Federal Circuit issued its decision, U.S. Surgical petitioned the Federal Circuit for rehearing *en banc*. That petition was denied. The denial of that petition reflects a determination by all of the judges of the Federal Circuit that the decision below is consistent with the controlling precedent of the *Markman* case.

SUMMARY OF ARGUMENT

The decision below applied settled law to unique facts. The court below held merely that any alleged error in the denial of U.S. Surgical's proposed instructions on claim construction did not reasonably prejudice the outcome based on the particular facts of this case. That fact-specific determination was consistent with *Markman* and does not merit this Court's review.

REASONS FOR DENYING THE PETITION

I. U.S. Surgical's "Questions Presented" Concerning *Markman* Are Not Fairly Presented by the Facts of this Case

It is not the practice of this Court to grant certiorari in order to comment on isolated phrases that appear in lower court decisions. But that is what U.S. Surgical asks this Court to do.

U.S. Surgical takes snippets out of context from the Federal Circuit's decision and patches them together to concoct a legal issue of its own creation. At the same time, U.S. Surgical carefully ignores the Federal Circuit's actual holding—that "in light of the particular issues in this case concerning the prior art, the claimed invention, and the Court's discussion in *Markman*, we conclude that the omission of the requested instructions did not prejudice the determination of obviousness." *U.S. Surgical v. Ethicon*, 103 F.3d at 1570.

For example, U.S. Surgical asks this Court to grant certiorari in order to hold that "*Markman* Contains No Exception for Claims Challenged for Obviousness." Pet. at 13. This case does not fairly present that question for review.

The Federal Circuit has not held—in this case or in any other post-*Markman* case disclosed by our

research—that juries should construe the claims where the issue is obviousness. To the contrary, the Federal Circuit explicitly recognized in this case that claim construction may bear on obviousness in some cases. *U.S. Surgical v. Ethicon*, 103 F.3d at 1568. All that the Federal Circuit held is that this was not such a case because omission of the instructions U.S. Surgical requested on claim construction did not "reasonably prejudice" the outcome on obviousness in view of the particular facts of this case. *Id.*, 103 F.3d at 1568, 1570. Nothing about that determination merits this Court's review. Moreover, in other post-*Markman* decisions, the Federal Circuit has repeatedly construed claim language as a matter of law where the ultimate issue is obviousness. *See, e.g., Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1569-72 (Fed. Cir. 1997); *Valmet Paper Machinery, Inc. v. Beloit Corp.*, 105 F.3d 1409, 1413-14 (Fed. Cir. 1997).

U.S. Surgical also asks this Court to grant certiorari in order to hold that "*Markman* Contains No Exception Limiting Its Rule to 'Technical Terms' and 'Terms of Art.'" Petition at 10. Once again, U.S. Surgical concocts a holding that is not found in the decision below.

The court below did *not* hold that *Markman* is applicable only to technical terms or terms of art. Instead, it held that "U.S. Surgical has not shown" on the particular facts of this case "that there are unclear or ambiguous technical terms or words of art or related aspects of claim scope whose 'construction' as requested by U.S. Surgical would negate the verdicts of obviousness." *U.S. Surgical*

v. Ethicon, 103 F.3d at 1570. Once again, there is nothing about that conclusion that merits this Court's review.

Moreover, the central premise of U.S. Surgical's petition—that the Federal Circuit, or at least three of its judges, are in open rebellion against *Markman*—is utterly absurd. In the eighteen months since this Court's *Markman* decision, the Federal Circuit has consistently treated claim construction as an issue of law with respect to technical *and* non-technical terms in patent claims.[1] The reported decisions provide no reason to believe that the Federal Circuit is in rebellion against this Court's decision in *Markman*, as U.S. Surgical imagines it to be. In fact, one year before this Court's decision in *Markman*, the Federal Circuit adopted the same rule in an *en banc* decision in the same case. *See, Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 116 S.Ct. 1384 (1996) (construing the word "inventory" as a matter of law).

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[1] *See, e.g., Kegel Co., Inc. v. AMF Bowling*, No. 96-1178, __F.3d__, 1997 WL 574561 at *3, 6 (Fed. Cir. Sept. 17, 1997) (construing the word "assembly" as a matter of law); *Wright Medical Technology, Inc. v. Osteonics Corp.*, No. 97-1007, __F.3d__, 1997 WL 526204 at *3-4 (Fed. Cir. Aug. 27, 1997) (construing "closely fit" and "extend through" as matters of law); *In re Morris*, No. 96-1425, __ F. 3d __, 1997 WL 467688, at *6 (Fed. Cir. Aug. 18, 1997) (construing the word "portion"); *Eastman Kodak Co. v. The Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1997) (construing the words "to," "at," and "under").

II. The Dictionary Issue Does Not Merit This Court's Review

The court below also found there was no reasonable possibility that the trial court's submission of a standard dictionary to the jury prejudiced the outcome of this case. *U.S. Surgical v. Ethicon*, 103 F.3d at 1569. U.S. Surgical now asks the Court to grant certiorari to review that issue.

However, the "near universal consensus [is] that a new trial is not awarded simply because a dictionary was before the jury." *Wernsing v. General Motors Corp.*, 470 A.2d 802, 806 (Md. 1984). That "near universal consensus" is grounded in clear logic and common sense. "Jurors are expected to bring commonly known facts . . . to bear in arriving at their verdict," *Shillcutt v. Gagnon*, 827 F.2d 1155, 1159 (7th Cir. 1987), and "the definition of words in our standard dictionaries is . . . a matter of common knowledge which the jury is supposed to possess." *State v. Asherman*, 193 Conn. 695, 478 A.2d 227, 252 (1984), *cert. denied*, 470 U.S. 1050 (1985).

For this reason, numerous courts have held that a jury's exposure to a standard dictionary provides no grounds for a new trial. *See, e.g., United States v. Turner*, 936 F.2d 221, 226 (6th Cir. 1991); *United States v. Cheyenne*, 855 F.2d 566, 568 (8th Cir. 1988); *United States v. Steele*, 785 F.2d 743, 746 (9th Cir. 1986); *Copeland v. Gulf Oil Corp.*, 672 F.2d 867, 871-72 (11th Cir. 1982); *United States v. Duncan*, 598 F.2d 839, 866

(4th Cir.), *cert. denied*, 444 U.S. 871 (1979); *United States v. Gunter*, 546 F.2d 861, 869 (10th Cir.), *cert. denied*, 431 U.S. 920 (1977); *Asherman*, 478 A.2d at 252; *Wernsing*, 470 A.2d at 806.

U.S. Surgical argues that the district court was required to hold an evidentiary hearing on the jury's use of the dictionary. But "there is no magic procedure that the district court must follow when informed that the jury may have used a dictionary." *United States v. Gillespie*, 61 F.3d 457, 460 (10th Cir. 1991). Under Rule 606(b), Fed. R. Evid., the only permissible issue in such a hearing would have been *whether* the trial court permitted the jury to see a dictionary, not *how* the jury used it. *United States v. Simpson*, 950 F.2d 1519, 1521 (10th Cir. 1991). Since there was no dispute that the trial court permitted the jury to see the dictionary, the kind of hearing that U.S. Surgical advocated would have been an unnecessary "exercise in futility." *Id. Accord, Duncan*, 598 F.2d at 866 (affirming the denial of a new trial in the absence of a hearing, where the jury obtained and used a dictionary without the trial court's approval).

Even assuming *arguendo* that the dictionary was "extraneous" information, every circuit that has considered the issue since the enactment of Rule 606(b) in 1974 has agreed that trial judges have broad discretion in deciding whether a jury's use of extraneous information is prejudicial in light of other evidence, and that courts are

not required to hold evidentiary hearings to make that determination. [2]

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[2] *See,e.g., United States v. Old Chief*, No. 96-6556, __F.3d__, 1997 U.S. App. LEXIS 17610, at *9 (9th Cir. Jul. 15, 1997) ("'not every allegation that extraneous information has reached the jury requires a full-dress hearing,'" quoting *United States v. Langford*, 802 F.2d 1176, 1180 (9th Cir. 1986), *cert. denied*, 483 U.S. 1008 (1987)); *United States v. Williams-Davis*, 90 F.3d 490, 496 (D.C.Cir. 1996) (recognizing "broad discretion in the trial court to assess the effect of alleged intrusions"), *cert. denied*, 117 S. Ct. 986 (1997); *United States v. Jobe*, 101 F.3d 1046, 1058 (5th Cir. 1996), ("[t]he procedures used to investigate allegations of juror misconduct and the decision as to whether to hold an evidentiary hearing are matters which rest solely within the sound discretion of the district court."), *petition for cert. filed*, 66 U.S.L.W. 3422 (June 25, 1997) (96-2050); *Gillespie*, 61 F.3d at 460 ("there is no magic procedure the district court must follow when informed that the jury may have used a dictionary."); *Simpson*, 950 F.2d at 1521 (stating that Rule 606(b) precludes hearings on how juries use information submitted to them); *United States v. Gilsenan*, 949 F.2d 90, 97 (3d Cir. 1991) (finding no abuse of discretion in a district court's decision not to hold an evidentiary hearing into possible prejudice resulting from unauthorized communications with jurors), *cert. denied*, 504 U.S. 987 (1992); *United States v. Key*, 859 F.2d 1257, 1263-64 (7th Cir. 1988) (holding that courts of appeals generally should defer to trial courts' determinations regarding prejudice); *United States v. Conover*, 772 F.2d 765, 769 (11th Cir. 1985) (stating that there is no *per se* requirement to hold evidentiary hearings concerning possible jury misconduct), *aff'd in part, rev'd in part on other*

U.S. Surgical argues that the Federal Circuit's treatment of the dictionary issue is in "sharp disagreement" (Pet. at 19) with a decision by the Second Circuit in a case not involving a dictionary, *United States v. Weiss*, 752 F.2d 777. However, the holding in *Weiss* is completely consistent with this case. Unlike this case, *Weiss* involved "extraneous" information concerning accounting principles that were not matters of common knowledge, which the jury obtained on its own without the trial court's imprimatur. In this case, the dictionary was not "extraneous" material because it was provided to the jury by the trial court on notice to both parties. *Weiss* did not require the trial court to hold an evidentiary hearing on the jury's use of such material and, as the Federal Circuit correctly noted, does not require "an automatic new trial" in the absence of such a hearing. *U.S. Surgical v. Ethicon*, 103 F.3d at 1569.

U.S. Surgical is also wrong when it argues that the decision below conflicts with the Ninth Circuit's decision

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grounds, Tanner v. United States, 483 U.S. 107, 127 (1987); *United States v. Weiss*, 752 F.2d 777, 783 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985) (holding that trial courts have "broad discretion in reviewing the prejudicial effect of the infiltration of extra-record evidence"; not requiring an evidentiary hearing to make that assessment); *Duncan*, 598 F.2d at 866 ("the district court may deal with such claims [of juror misconduct] as it feels the particular circumstances require and [we] have only reversed for abuse of discretion."). *But see United States v. Bagnariol*, 665 F.2d 877, 884 (9th Cir. 1981).

in *Dickson v. Sullivan*, 849 F.2d 403 (9th Cir. 1988), and with the Fifth Circuit's decision in *Paz v. United States*, 473 F.2d 662 (5th Cir.), *cert. denied*, 414 U.S. 820 (1973). These cases state that a new trial is necessary where there is a "'reasonable possibility'" that extraneous information could have tainted a jury's verdict. *Dickson*, 849 F.2d at 405, quoting *Marino v. Vasquez*, 812 F.2d 499, 504 (9th Cir. 1987); *Paz v. United States*, 473 F.2d at 663. The Federal Circuit applied the same standard here. It expressly found on the facts of this case that it could not identify "any . . . reasonably possible prejudice" from the submission of the dictionary.[3] *U.S. Surgical v. Ethicon*, 103 F.3d at 1569.

Palestroni v. Jacobs, 10 N.J. Super. 266, 271, 77 A.2d 183, 185 (App. Div. 1950), which U.S. Surgical also cites, apparently is no longer the law in New Jersey. More recent decisions from the same New Jersey court have held that a jury's access to a dictionary was "incapable of producing an unjust result," without any need to hold an evidentiary hearing on that issue. *See, State v. Watson*,

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[3] U.S. Surgical 's speculation that the jury may have used the dictionary to look up the word "obvious" (Pet. at 19-20) mistakenly assumes that the jury disregarded the trial court's detailed instructions on the obviousness issue. As the court below stated, "[t]he instructions on the law of obviousness occupied eight pages of trial transcript. They were correct in law, thorough, and clearly stated." *U.S. Surgical v. Ethicon*, 103 F.3d at 1565. The jury is presumed to have followed those instructions. *Greer v. Miller*, 483 U.S. 756, 765 (1987).

261 N.J. Super. 169, 181, 618 A.2d 367, 373 (1992), *cert. denied*, 627 A.2d 1145 (1993).

As demonstrated above, *Weiss* and other cases consistently recognize that trial courts have "broad discretion" in assessing the impact of extraneous information based on the facts of the particular case. *Weiss*, 752 F.2d at 783. In the exercise of that "broad discretion," the trial court here found that the submission of the dictionary did not prejudice U.S. Surgical. Appendix to Pet. at 67a. On appeal, the Federal Circuit agreed that there was no "reasonably possible prejudice" in the submission of the dictionary to the jury.[4] *U.S.*

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[4] It bears emphasizing in this context that the Federal Circuit often relies upon dictionary definitions when it construes non-technical terms in patent claims. *See, e.g., Morris*, __F.3d__, 1997 WL 467688, at *6 (citing *Webster's Third New International Dictionary* in construing the word "portion"); *Eastman Kodak*, 114 F.3d at 1552 (citing *Webster's II New Riverside Dictionary* in construing the words "to," "at," and "under"); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) (citing *Webster's Encyclopedic Unabridged Dictionary* in construing the word "perforation"), *petition for cert. filed*, 65 U.S.L.W. 3794 (May 19, 1997) (No. 96-1858). Indeed, the Federal Circuit has repeatedly relied upon the same standard dictionary that the jury was given here. *See, e.g., Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 951 n.8 (Fed. Cir. 1993) (definition of "straw"); *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 876 (Fed. Cir. 1993) (definition of "cabinet"), *cert. denied*, 510 U.S. 1100 (1994). Other courts

Surgical v. Ethicon, 103 F.3d at 1569. That finding is consistent with the overwhelming majority of dictionary cases and with case law from every circuit. There is no basis for reviewing the matter on certiorari.

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have cited that dictionary in more than 400 cases. *See, e.g., Board of Trustees of the CWA/ITU Negotiated Pension Plan v. Weinstein*, 107 F.3d 139, 142 (2d Cir. 1997); *In re Paoli R.R. Yard PCB Litig.*, 113 F.3d 444, 467 (3rd Cir. 1997); *Faircloth v. Lundy Packing Co.*, 91 F.3d 648, 653 (4th Cir. 1996), *cert. denied*, 117 S. Ct. 738 (1997); *Associated Builders Corp. v. Ratcliff Constr. Co.*, 823 F.2d 904, 906 (5th Cir. 1987); *Wisconsin Elec. Power Co. v. Reily*, 893 F.2d 901, 908 (7th Cir. 1990); *City of Ketchikan v. Cape Fox Corp.*, 85 F.3d 1381, 1384 (9th Cir. 1996).

CONCLUSION

For the reasons set forth above, this Court should deny U.S. Surgical 's petition for a writ of certiorari.

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Respectfully submitted,

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